



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,052	09/24/2001	Hirokazu Tanaka	K-1827CON	6719

7590 04/05/2004
KANESAKA AND TAKEUCHI
1423 Powhatan Street
Alexandria, VA 22314

EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/961,052

Applicant(s)

TANAKA ET AL.

Examiner

Frank I Choi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



S. MARK CLARDY
PATENT EXAMINER
GROUP 1200 1616

Continuation of 5. does NOT place the application in condition for allowance because: Examiner has duly considered Applicant's arguments but deems them unpersuasive for the reasons of record and the further reasons below. Applicant argues that silicic acid solution used in the invention is different from silicic acid and silicate, however, Applicant's arguments do not show that silicic acid as used in the prior art is different from silicic acid solution set forth in the Specification or that the silicic acid solution described in "The Chemistry of Silica" is the same as the silicic acid solution disclosed in the Specification. Applicant's translation shows that the silicic acid in the prior art is in solution and, as such, appears to meet the claim limitation. Applicant argues that its claims do not require heating and cooling, however, the claims do not exclude said steps. Further, Applicant's own specification sets forth examples in which heating and inherently cooling is used to prepare the composition. With respect to JP'406 Applicant does not cite to any part of said reference which supports the argument that silicic acid solution is not used deposit the silica layer on the particles. Applicant admits that the silicic acid is in solution and the particles are dispersed in the same. As such, the rejection of the claims 1-6 over JP 48-29528 and claims 1-8 over JP 60-228406 is maintained. With respect to the incorporation of essential material, as indicated in the prior Office Action, Applicant cannot incorporate essential material by reference to a publication which is not a US Patent. Applicant's amendment does not alter the fact that the Specification is incorporating by reference (in fact the amendment specifically states that it is incorporating by reference) to a publication which is not a US Patent. Said amendment to the Specification raises the issue of new matter as there is no indication from citing merely to JIS Z 8730 that Applicant intended that JIS Z 8722 be also incorporated into the Specification. And even if the same were attached, there is no indication that the copies attached are the version of the JIS Z 8730 or JIS Z.8722 which were intended to be used at the time the application was filed for purposes of satisfying the rejection of claims 2,3 under 35 USC 112, 2nd paragraph. Examiner notes that the IFW file has no copies, i.e. there are no scanned images, of JIS Z 8722, JIS Z 8730 or "The Chemistry of Silica", as such, Examiner respectfully requests that Applicant provide the same in the next response.